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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,478	02/14/2000	Noriaki Tanaka	862.C1821	6658

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/503,478

Applicant(s)

TANAKA, NORIAKI

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/21/05, and has been entered and made of record. Currently, **claims 1-15** are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 1 is objected to because of the following informalities:

Line 6, "image information" should be -- the image information --;

Perhaps, lines 6-7, "the print request including information for designation for designating as a print destination" should be -- the print request wherein the print request includes information for designation for designating as a print destination --.
4. Claim 2 is objected to because of the following informalities:

Line 3, "image information" should be -- the image information --.
5. Claim 4 is objected to because of the following informalities:

Lines 2 and 5, "image information" should be -- the image information --; and

Line 4, "a terminal device" should be -- the terminal device --.
6. Claim 7 is objected to because of the following informalities:

Line 2, "image file names" should be -- the image file names --.

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7. With respect to claims 8-9, 11 and 14, arguments analogous to those presented for claims 1-2, 4 and 7, are applicable.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7-10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation "a printer" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is uncertain as to whether this printer is referring to the same printer presented in the preamble.

Claim 2 recites the limitation "a printer" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is uncertain as to whether this printer is referring to the same printer presented in the preamble or other printer.

Claim 3 recites the limitation "a printer" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is uncertain as to whether this printer is referring to the same printer presented in the preamble or other printer.

It is uncertain if there are two printers used in the claims. If so, examiner kindly suggests the applicant to distinguish two different printers using the terms "first printer", "second printer" or the like, throughout the claims.

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9. With respect to claims 8-10, arguments analogous to those presented for claims 1-3, are applicable.

10. Claim 7 recites the limitation "printing date" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is uncertain as to whether this printing date is referring to the printing date claimed in claim 1.

11. With respect to claim 14, arguments analogous to those presented for claim 7, are applicable.

12. With respect to claim 1, it recites "management unit adapted to manage record information including date of the printing performed by the printer based on the instruction by said first designating unit". It is uncertain as to whether the management unit stores the date when the printing was performed or the date of printing to be performed.

13. With respect to claim 8, arguments analogous to those presented for claim 1, are applicable.

14. With respect to claim 2, it is understood that there are two terminal devices claimed: one for sending the print request and another for transferring the image information to the printer. It is uncertain as to which one of the two terminal devices comprises the second designating unit adapted to designate a printer that is to print the image information. Does the second designating unit designate the printer based on

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the print request including the information for designating a printer? In other words, when exactly is the second designating unit used? Is it before sending the print request or the after? Is there any relationship between the information for designating a printer as a print destination (claim 1, lines 6-7) and the second designating unit?

15. With respect to claim 9, arguments analogous to those presented for claim 2, are applicable.

16. With respect to claim 3, it is uncertain as to how the image information can be transferred directly from a terminal device (201a of fig.2) to a printer (202b) that is connected via a network. Can the image information be directly transferred from the terminal device 201a to the printer 202b without passing through another terminal device 201c? The term "directly transfer" is not clearly understood with respect to the claim and the drawings.

17. With respect to claim 10, arguments analogous to those presented for claim 3, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry U.S. Patent No. 6,385,728 in view of Takahashi et al. U.S. Patent No. 6,424,429 (hereinafter Takahashi).

18. With respect to claim 1, DeBry discloses an information processing apparatus (print server 30 in fig. 1) for instructing a specified terminal device (document source 10) of a plurality of terminal devices connected via a network to transfer image information to a printer (printer 10 in col. 6, lines 62-67) in response to a print request from one of the plurality of terminal devices (user 20), said apparatus comprising:

specifying unit adapted to specify a terminal device, in which the image information to be printed has been stored, in accordance with the print request wherein the print request includes information for designation for designating as a print destination (step 4 in fig. 1 & col. 7, lines 20-41); and

a first designating unit adapted to instruct the terminal device specified by said specifying unit to directly transfer the image information to the printer designated as the print destination (col. 6, lines 63-64 & col. 8, lines 35-36).

DeBry, however, does not disclose the management unit adapted to manage record information including printing data of the printing performed by the printer based on the instruction by said first designating unit.

Takahashi, the same field of endeavor of the printing art, discloses the management unit adapted to manage record information including printing data of the printing performed by the printer based on the instruction by said first designating unit (col. 15, lines 58-67 & figs. 21 & 23).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the management unit of Takahashi with the printing system of DeBry.

The suggestion/motivation for doing so would have been to keep the record of the processed date to be accessed by the user.

Therefore, it would have been obvious to combine DeBry with Takahashi to obtain the invention as specified in claim 1.

19. With respect to claim 2, DeBry discloses the apparatus, wherein each of the plurality of terminal devices comprises a second designating unit adapted to designate a printer that is to print image information (col. 7, lines 36-42), and

said first designating unit instructs transfer of the image information in dependence upon mode of connection between the printer designated by said second designating unit and the terminal device storing the image information (col. 6, lines 63-64 & col. 8, lines 35-36).

20. With respect to claim 3, DeBry discloses the apparatus, wherein said first designating unit instructs transfer of the image information in dependence upon whether said terminal device and printer are connected locally or via a network (col. 6, lines 63-64 & col. 8, lines 35-36). It is inherent/obvious to one of ordinary skill in the art that when the printer ID corresponds to the local printer the image information is transferred locally and when the printer corresponds to the network printer the image information is transferred via network.

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21. With respect to claim 4, DeBry discloses the apparatus, wherein said specifying unit includes a management database for managing image information as image file names (col. 8, line 18),

and wherein said specifying unit specifies the terminal device, which is storing image information to be printed, based upon an image file name that has been registered in said management database (col. 7, lines 21-35 & col. 7, line 50 – col. 8, line 5). Note that the “will-call” information must be stored either permanently or temporarily for accessing the document source.

22. With respect to claim 5, DeBry discloses the apparatus, wherein the image file name is a combination of a unique file name in the terminal device storing the image information and an identifier of this terminal device (col. 7, lines 20-41).

23. With respect to claim 6, Takahashi discloses the apparatus further comprising a totalization unit adapted to totalize statistical information based upon attribute information in said management database (figs. 21 & 23).

24. With respect to claim 7, Takahashi discloses the apparatus wherein the attribute information includes information on identifier, the image file names, number of pages to be printed and printing date (fig. 23). Also, refer to col. 7, lines 21-41 of DeBry.

25. With respect to claim 8, arguments analogous to those presented for claim 1, are applicable.

26. With respect to claim 9, arguments analogous to those presented for claim 2, are applicable.

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27. With respect to claim 10, arguments analogous to those presented for claim 3, are applicable.

28. With respect to claim 11, arguments analogous to those presented for claim 4, are applicable.

29. With respect to claim 12, arguments analogous to those presented for claim 5, are applicable.

30. With respect to claim 13, arguments analogous to those presented for claim 6, are applicable.

31. With respect to claim 14, arguments analogous to those presented for claim 7, are applicable.

32. With respect to claim 15, arguments analogous to those presented for claim 1, are applicable. Also, read col. 16, lines 21-24 of DeBry.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
July 18, 2005

Chan S. Park
Examiner
Art Unit 2622


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SUPERVISORY PATENT EXAMINER
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